

### **REMARKS**

Claims 1, 3-15, 44, 54 and 55 are pending. The Examiner has withdrawn claims 27-30, 32-34, 36-43, 49-51, 53, 56-57 and 58 from consideration. Claim 27 has been amended to correct a typographical error. New claims 60 and 61 have been added. No new matter has been added.

### **RESTRICTION REQUIREMENT**

Applicant affirms the provisional election of Group I, claims 1, 3-15, 44, 54 and 55 on February 12, 2009. This election is being made without traverse.

### **CLAIM REJECTIONS**

#### ***Rejection of claims under 35 U.S.C. § 112 and 35 U.S.C. § 132(a)***

The Examiner has maintained the rejection of claims 1, 3-15, 44 and 54-55 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. See Office Action at p. 6. The Examiner has also maintained the new matter rejection of the claim amendments filed on November 9, 2006. Claims 1 and 54 are independent claims. The Examiner maintains that the phrase “the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater” is not supported by the specification. See Office Action at p. 6. The Examiner has referred to the Declarations of Roger A. Laboube and Francis J. Roost, both filed on September 8, 2007, and contends that both declarations do not show “the equivalence of the 1:8 ratio and the specification page 6, line 26.” See Office Action at p. 11. Additionally the Examiner states that “the information in the declaration does not overcome the new matter rejection nor does it overcome or influence in any way the prior art rejection.” *Id.* The Declarations were submitted as secondary evidence of non-obviousness. Applicant submits that the Examiner has continued to maintain the new matter rejection over several Office Actions but has failed to articulate to the Applicant the precise reasons why the Examiner does not find support in the specification despite Applicant's showing of support in the specification.

MPEP 2163.02 states that “[t]he subject matter of the claim **need not be described literally** in order for the disclosure to satisfy the description requirement.” (emphasis added).

Rather, it is sufficient if the "description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *Id.* MPEP 2163.02 further states that

[u]nder *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

The phrase "the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater" is supported by Figures 1 and 6 of the specification. For example, Figure 6 of the specification illustrates that "the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater." When measured directly from Figure 6, the distance between adjacent slots prior to expansion is 1/8<sup>th</sup> of an inch whereas the width of the formed sheet prior to expansion is an inch. See Figure 6 of the specification.

MPEP 2163.02 also states that

[a]n applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations **using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.** *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the **disclosure of drawings** or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997); *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991) (one must define a compound by "whatever characteristics sufficiently distinguish it").

(emphasis added).

Accordingly, the specification sufficiently describes the claimed invention in full, clear, concise and exact terms. Applicants respectfully requests reconsideration and withdrawal of this rejection.

***Rejection of claims under 35 U.S.C. §103***

***Sucato***

The Examiner has rejected claims 1, 3-5, 9, 11-14 and 54-55 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,605,024 to Sucato et al. ("Sucato"). See Office Action at p. 6. Claims 3-5, 9, 11-14 depend from independent claim 1. Claim 55 depends from independent claim 55.

Claim 1 relates to a metal framing member including a formed metal sheet having a length and including a web region including a plurality of expanded web slots including voids and metal web elements and extending along a portion of the length, wherein the region includes a plurality of reinforcements proximate to the web slots and confined to the web elements and exclusive to the web voids, each expanded web slot has a length to width ratio of 2:1 or greater, and the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater. Claim 54 relates to a metal framing member including a formed metal sheet including a plurality of expanded web slots in a region of the formed metal sheet, wherein the expanded web slots are heat treated, each expanded web slot having a length to width ratio of 2:1 or greater, and the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater.

The Examiner contends that "Sucato et al discloses a metal framing member comprising: a formed metal sheet ...." See Office Action at p. 7. The Examiner cites to numeral elements 64, 65, 66 as equivalents to web region, web slots and reinforcements respectively. *Id.* Applicant respectfully traverses this contention.

Sucato describes a "claimed assembly [that] comprises a pair of U-shaped channels the legs of which are arranged to face each other in a parallel spaced arrangement and are interconnected by a rigid stiffener." (emphasis added). See col. 2, lines 11-14. Sucato also explains that "[t]his stiffener extends between the U-shaped channels and into the legs of each of

the channels to attach them in a rigid configuration to form the novel stud assembly.” See col. 2, lines 14-17. Sucato further states that

FIGS. 20 and 21 disclose a stud 61 comprising a pair of U-shaped members 62 and 63 which may be formed of a metallic material that are interconnected by bight 64 comprising an expandable mesh 65. The expandable mesh originally comprised a flat piece of metal stamped to form a mesh configuration the physical orientation of which may be varied by moving one of the members 62 and 63 away from or toward the other as indicated by the arrows in FIG. 21, to increase or decrease the width of the mesh.

(emphasis added). See col. 4, lines 22-30 of Sucato. Sucato refers to “channels or studs for walls of buildings and more particularly to a stud assembly comprising a pair of channels held together by a stiffener at one or more points or places along their length to form a new and improved stud assembly.” See col. 1, lines 10-14 of Sucato and see also, Figures 2, 3, 9, 13, 12-18 and 19. Sucato further describes that “FIG. 2 illustrates a modification of the prior art structure shown in FIG. 1 wherein channel or stud assembly 25 comprises two members 26 and 27.” See col. 3, lines 16-22 of Sucato. As such, Sucato does not teach or suggest a metal framing member including a formed metal sheet having a length and including a web region including a plurality of expanded web slots including voids and metal web elements and extending along a portion of the length and including a web region including a plurality of expanded web slots including voids and metal web elements and extending along a portion of the length, wherein the region includes a plurality of reinforcements proximate to the web slots and confined to the web elements and exclusive to the web voids, each expanded web slot has a length to width ratio of 2:1 or greater, and the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater. Sucato also does not teach or suggest a metal framing member including a formed metal sheet including a plurality of expanded web slots in a region of the formed metal sheet, wherein the expanded web slots are heat treated, each expanded web slot having a length to width ratio of 2:1 or greater, and the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater.

The Examiner contends that “Applicant has not shown the criticality and relevancy for including these ratios” and that “Applicant has not shown that ratios outside the recited ratios

cause the farming member to not function as intended or to function unfavorably." See Office Action at p. 7. Applicant respectfully traverses these contentions.

The criticality and relevancy of these ratios with respect to the formed metal sheet should not be taken into account in an obviousness rejection. Nevertheless, Applicant resubmits a Declaration by Jeffrey A. Anderson ("the Anderson Declaration"), attached at Appendix A, was previously filed on November 9, 2006. The Anderson Declaration states that "[t]he combination of a plurality of reinforcements proximate to the web slots and confined to the web elements and exclusive to the web voids, each expanded web slot having a length to width ratio of 2:1 or greater, and the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater are necessary to achieve the structure on the web that is not available when these features are not all present in combination." See paragraph 4 of the Anderson Declaration. Thus, Applicant has demonstrated the criticality and relevancy of these ratios with respect to the formed metal sheet. In contrast, the Examiner has not provided any factual support or evidence as to why the Examiner doubts the criticality and relevancy of the ratios with respect to the formed metal sheet. Applicant further submits that there is no requirement in patent law that Applicant must show "that ratios outside the recited ratios cause the farming member to not function as intended or to function unfavorably."

Accordingly, claims 1 and 54, and claims that depend therefrom are patentable over Sucato for at least the reasons discussed above. Applicant requests that this rejection be reconsidered and withdrawn.

***Sucato and Ekerholm***

The Examiner has rejected claims 6-8 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Sucato in view of U.S. Patent no. 6,205,740 to Ekerholm ("Ekerholm"). See Office Action at p. 9. Claims 6-8 and 10 depend from independent claim 1.

As explained above, Sucato does not teach or suggest a metal framing member including a formed metal sheet having a length and including a web region including a plurality of expanded web slots including voids and metal web elements and extending along a portion of the length and including a web region including a plurality of expanded web slots including voids and metal web elements and extending along a portion of the length, wherein the region includes

a plurality of reinforcements proximate to the web slots and confined to the web elements and exclusive to the web voids, each expanded web slot has a length to width ratio of 2:1 or greater, and the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater.

Such a defect is not remedied by Ekerholm either. Ekerholm describes “[a]n elongate supporting element [that] has a cross section with a web (9) and two side flanges (10, 11) for the supporting of building panels or the like.” See Abstract. Ekerholm does not teach or suggest a metal framing member including a formed metal sheet having a length and including a web region including a plurality of expanded web slots including voids and metal web elements and extending along a portion of the length and including a web region including a plurality of expanded web slots including voids and metal web elements and extending along a portion of the length, wherein the region includes a plurality of reinforcements proximate to the web slots and confined to the web elements and exclusive to the web voids, each expanded web slot has a length to width ratio of 2:1 or greater, and the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater.

Accordingly, claim 1, and claims that depend therefrom are patentable over Sucato and Ekerholm for at least the reasons discussed above. Applicant requests that this rejection be reconsidered and withdrawn.

**Dependent claims are also independently patentable**

All other dependent claims contain subject matter that is independently patentable and not shown by the cited references. For example, claim 9 relates to a member in which the formed metal sheet further includes a closing region extending the first flange to the second flange to form a substantially tubular structure, claim 39 relates to a method in which a formed metal sheet further includes a closing region extending the first flange to the second flange to form a substantially tubular structure. New claims 60 and 61 are similarly patentable. These features are neither taught nor suggested by Sucato or Ekerholm.

**CONCLUSION**

For the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the pending rejections.

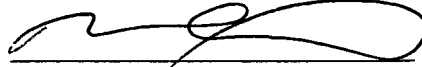
Applicant : Jeffrey A. Anderson  
Serial No. : 10/633,694  
Filed : August 5, 2003  
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Applicant believes that the claims now pending are in condition for allowance. Should any further fees be required by the present Reply, the Commissioner is hereby authorized to charge Deposit Account **19-4293**.

Respectfully submitted,

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